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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,383	08/20/2004	Peter J Dronzek JR.	181-039	7142
7590 11/26/2007				
James V Costigan Hedman & Costigan 1185 Avenue of the Americas New York, NY 10036-2601				
			EXAMINER AHMAD, NASSER	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/505,383	<b>Applicant(s)</b> DRONZEK ET AL.	
	<b>Examiner</b> Nasser Ahmad	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/2007 has been entered.

### ***Rejections Maintained***

2. Claims 1-97 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No. 10/505392 for reasons of record made in the last Office Action of 7/6/06 and maintained in the Office Action of 2/7/2007.

### ***Response to Arguments***

3. Applicant's arguments filed 7/9/2007 have been fully considered but they are not persuasive.

For the double patenting rejection, applicant's request that *since this is a provisional rejection because no claims have been allowed in the copending application, it is requested that this ground of rejection be held in abeyance pending the allowance of*

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*copending application Serial No. 10,505,392* is noted. However, in the absence of overcoming said double patenting rejection, said rejection is being maintained.

***Rejection Withdrawn***

4. Claims 1-4, 7-15, 18-26, 29-37, 40-48, 51-59, 62-70, 73-81, 83-88 and 97 are rejected under 35 U.S.C. 102(b) as being anticipated by Egan (4544590) made in the Office Action of 7/6/06 and maintained in the Office Action of 2/7/2007 has been withdrawn in view of the amendment filed on 7/9/2007 with the RCE filed on 9/7/2007.

5. Claims 5-6, 16-17, 27-28, 39-40, 49-50, 60-61, 71-72 and 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Kobe (6780484) made in the Office Action of 7/6/06 and maintained in the Office Action of 2/7/2007 has been withdrawn in view of the amendment.

6. Claims 89-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Grabau (7045186) made in the Office Action of 7/6/06 and maintained in the Office Action of 2/7/2007 has been withdrawn in view of the amendment

***Response to Arguments for the Rejections Withdrawn***

7. Applicant's arguments with respect to claims 1-97 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 7-15, 18-26, 29-37, 40-48, 51-59, 62-70, 73-81, 83-88 and 97 are rejected under 35 U.S.C. 102(b) as being anticipated by Egan (4544590).

Egan (for claims 1, 12, 24, 34, 45, 56, 67, 78, 97) relates to an article of manufacture (figure-6) comprising a first support layer of film (1+2) with a permanent bond interface with adhesive (19), a second thin film (13) is adhesively secured to the lower surface of the first film at the permanent adhesive bond but having a separable interface between the adhesive and the release coat of film (13), and a third substrate (33) is laminated to the upper surface of the first layer with adhesive (37). As shown in figure-9, the article is a die-cut segment (47) wherein in the die-cut extends through all the layers except for film (13). The removable die-cut segment is provided with a selective variable adhesion through variable surface treatment (figure-21, wherein the release coat is provided in a discontinuous pattern) of the upper surface of film (13) such that the adhesion at the separable interface (between the release liner and the adhesive) is always less than the adhesion at the permanent interface between the adhesive and the film (1+2). This discontinuous pattern is formed by applying no surface treatment in some areas and surface treatment in other areas (as shown in figure-19-21 of Egan, the surface includes

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treated and non-treated areas for forming a variable adhesion , col. 9, lines 35-42 and 51-61, and col. 10, lines 1-5).

For claims 2, 13, 24, 35, 46, 57, 68, 79, the treated area extends under the removable area defined by the die-cut as shown in figure-21.

For claims 3, 14, 25, 36, 47, 58, 69, 80, the film layer is polyester and is about 0.5 mils thick (col. 6, lines 1-10).

As for claims 4, 15, 26, 37, 48, 59, 70, 81, the substrate layer can be of paper stock of 40-, 50-, or 60-pound weight (col. 6, lines 50-55).

For claims 7-10, 18-21, 29-32, 40-43, 51-54, 62-65, 73-76, 84-87, figure-21 shows that the area treated can be at least 10% but less than 90% and is of a geometric pattern such a polygon.

The intended use phrases such as "for providing", etc. and "optional" phrases have not been given any patentable weight because said phrases are found to be of positive limitations.

Claims 11, 22, 33, 44, 55, 66, 77, 88, are directed to a surface treatment condition in the process of making the product and has not been given any patentable weight because said process condition is not germane to the issue of patentability of the product itself.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-6, 16-17, 27-28, 39-40, 49-50, 60-61, 71-72 and 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Kobe (6780484).

Egan, as discussed above, fails to teach that the surface of the release liner film (13) is treated by flame treatment. Kobe discloses a release liner that has been flame treated to a dyne level of greater than 50 (col.18, 24-27) prior to silicone release coating. The treatment provides for stronger adhesion between the release coating and the liner. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Kobe's teaching of using a flame treated release liner surface in the invention of Egan with the motivation to provide for enhanced adhesion of the coating to the liner.

12. Claims 89-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Grabau (7045186).

Egan, as discussed above, fails to teach a radio frequency transmitter in at least one of the article elements. Grabau discloses a label with a radio frequency transmitter in at least one of the elements of the label (abstract). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Grabau's teaching of using radio frequency transmitter in a label in the invention of Egan with the motivation to provide for security y concern

### ***Response to Arguments***

13. Applicant's arguments filed 11/15/2006 have been fully considered but they are not persuasive.

Applicant argues that the *Egan* construction provides releasable layers that have constant adhesion and not variable adhesion that is provided with some areas treated and other areas not treated. The total treatment method *Egan* makes it difficult to raise an edge in order to begin to remove the removable portion. This is not deemed to be convincing because *Egan* shows in figures 19-21, that the surface is treated in a pre-determined pattern by applying surface treatment in some areas (areas coated with the release material) and non surface treatment in other areas (areas not coated by the release material).

In response to applicant's argument that the *Egan* does not disclose the concept of selective variable surface treatment as a technique for modifying the adhesion at an interface which is at one side of an adhesive while the interface at the opposite side of the adhesive layer is not modified, the above explanations apply a fortiori herein, in that *Egan* does disclose the presence of a discontinuous pattern of release material to provide for treated and non-treated areas.

With regard to the 35 USC 103 rejection, applicant argument that the *Egan* reference has been distinguished above based on the absence of a selective variable adhesion that is achieved by the application of a treatment in some areas while leaving other areas untreated, is noted. However, this is not found to be persuasive because, as explained hereinabove, *Egan* clearly teaches the variable surface treatment as shown in



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figure-21. Further, because Kobe clearly teaches the use of flame treatment to increase the dyne level or adhesion, it would have been obvious to utilize the teaching of Kobe to provide the selective surface treatment to exhibit enhanced adhesion characteristics.

As for the 35 USC rejection based on Egan in view of Gradbau, the above explanations apply a fortiori herein.

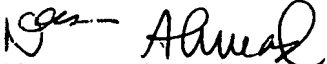
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner 11/21/07  
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N. Ahmad.  
November 21, 2007.